



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,351	02/21/2001	Takayuki Usui	Q61689	1061

7590 04/25/2005

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
Suite 800
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

EXAMINER

AUGHENBAUGH, WALTER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

35

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/788,351	Applicant(s) USUI ET AL.	
	Examiner Walter B. Aughenbaugh	Art Unit 1772	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: none.
- Claim(s) objected to: 21.
- Claim(s) rejected: 1-28.
- Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

2

ADVISORY ACTION

Acknowledgement of Applicant's Amendments

1. The After Final Amendment filed March 29, 2005 has not been entered due to the fact that it raises new issues that would require further consideration and/or search. The recitation “wherein the different Bekk smoothness of the two surfaces facilitate separation of the packaging material from the planographic printing plate during automatic feeding and prevents damage to the image surface of the printing plate” added to the end of claim 23 raises new issues that would require further consideration and/or search, and the recitation “whereby the imaging surface of the planographic printing plate is not damaged during the separation of the printing plate from the packaging material” of new claim 29 raises new issues that would require further consideration and/or search.

Response to Arguments

2. Applicant's arguments presented on pages 10-11 of the After Final Amendment regarding the 35 U.S.C. 112, first paragraph rejection of claims 10-12 that was repeated in paragraph 14 of the previous Office Action mailed October 29, 2004 have been fully considered but are not persuasive. As stated in paragraph 14 of the previous Office Action mailed October 29, 2004, the combination of the noncontact surface having a Bekk smoothness of 3 to 55 seconds and the contact surface having a Bekk smoothness of 8 to 560 seconds is not supported. Claims 11 and 12 are included in the rejection only because they depend upon claim 10, which recites that the contact surface has a Bekk smoothness of from 8 to 560 seconds. In the arguments presented on pages 10-11 of the After Final Amendment, Applicant has not pointed to a location in the specification where the particular range of from 8 to 560 seconds is supported.

Art Unit: 1772

Applicant's arguments predominately urge that there is support in the specification for the sheet material having different Bekk smoothness values on its contact and noncontact surfaces, but the Office has agreed that there is support for the sheet material having different Bekk smoothness values on its contact and noncontact surfaces (the 35 U.S.C. 112, first paragraph rejection of claims 1, 3, 5, 7, 8, 9, 11, 17 and 19-23 made of record in paragraph 14 of the Office Action mailed April 30, 2004 was withdrawn in the previous Office Action mailed October 29, 2004 due to Applicant's arguments on pages 16-18 of the Amendment filed July 30, 2004).

3. Applicant's arguments presented on pages 12-17 of the After Final Amendment regarding the 35 U.S.C. 103 rejection of claims 1, 2, 7-10, 13-16, 18-22 and 24-27 over Coppens et al. in view of Hayashi et al. in view of Usui have been fully considered but are not persuasive.

Applicant argues that there is no motivation to combine the references because "the density of an interleaf is not linked to the stabilization of the sensitivity of the photosensitive printing plate material" (page 14 of After Final Amdt.; it is stated in paragraph 16 of the previous Office Action that "one of ordinary skill in the art would have recognized to have synthesized the sheets taught by Coppens et al. and Hayashi et al. with the density specified by Usui in order to provide a paper capable of effectively protecting the printing plate and to enable stabilization of the sensitivity of the photosensitive printing plate material in a short period of time as taught by Usui"). While Usui may not explicitly link the density of an interleaf to the stabilization of the sensitivity of the photosensitive printing plate material as Applicant's argue, whereas air permeability is explicitly linked to the stabilization of sensitivity at col. 2, lines 35-41, density is necessarily linked to air permeability because the interleaf having a density of 0.8 g/cm^3 of Embodiment 1 of Usui (col. 2, lines 51-62) necessarily has an air permeability that falls within

Art Unit: 1772

the required range of Usui of between about 15 seconds and about 300 seconds because it is disclosed as an embodiment of the invention. Therefore, one of ordinary skill in the art would have recognized that a variation in the density of a bleached kraft pulp/water mixture would have resulted in a variation of the air permeability of the resultant interleaf and would have been motivated to vary the density of the bleached kraft pulp/water mixture in order to achieve the desired air permeability of the resultant interleaf.

On page 14 of the After Final Amdt., Applicant refers to, and repeats, an argument presented on pages 12-16 of the Amendment filed July 30, 2004. The Office's response to this argument is in the paragraph bridging pages 14 and 15 of the previous Office Action mailed October 29, 2004. In response to Applicant's argument that the three patents relied upon in the rejection are intended to store different items, and therefore the three references cannot be combined, the Office repeats that which is stated in the paragraph bridging pages 14 and 15 of the previous Office Action mailed October 29, 2004 and also notes that the particular item that is intended to be stored in any of the packages of the three references is a matter of intended use, and one of ordinary skill in the art would have recognized to have varied the properties of the particular interleaf in order to accommodate the particular item that is intended to be stored.

In response to Applicant's argument on page 16 of the After Final Amdt. that "[I]n Hayashi, however, the smoothness is considered for a different purpose", the fact that Applicant uses the smoothness values for a different purpose does not alter the conclusion that its use in a prior art device would be *prima facie* obviousness from the purpose disclosed in the reference. *In re Lintner*, 173 USPQ 560. Applicant argues that "[i]f an interleaf sheet of Hayashi is applied to the invention of Coppens, air permeability will be excessively large and stability of sensitivity

Art Unit: 1772

will not be maintained”, but this unsupported argument does not address the proposed combination of references at issue of Coppens et al., Hayashi et al. and Usui.

4. Applicant’s arguments presented on page 18 of the After Final Amendment regarding the 35 U.S.C. 103 rejections of claims 3-6, 11, 12 and 17 have been fully considered but are not persuasive. Applicant’s arguments depend entirely upon Applicant’s arguments regarding the 35 U.S.C. 103 rejection of claims 1, 2, 7-10, 13-16, 18-22 and 24-27 over Coppens et al. in view of Hayashi et al. in view of Usui, which have been addressed above in this Advisory Action.

5. Applicant’s arguments presented on pages 18-20 of the After Final Amendment regarding the 35 U.S.C. 103 rejection of claim 23 have been fully considered but are not persuasive. Applicant’s arguments regarding “facilitating separation [equivalently, “peelability”] and preventing damage to the printing material” are moot since the recitation regarding facilitation of separation and prevention of damage to the printing material has not been entered since it raises new issues that would require further consideration and/or search. Applicant’s statement that “[i]f an interleaf sheet of Hayashi is applied to the invention of Coppens, air permeability will be excessively large and stability of sensitivity will not be maintained” is unsupported. Applicant’s statement that “[i]f a sheet of Hayashi is applied to the printing plate system as set forth in claim 23, the smoothness will be excessively large and peelability will considerably deteriorate” is also unsupported, and is not directed to the proposed combination of references at issue of Coppens et al., Hayashi et al. and Busch. Applicant argues that Busch cannot be combined with Coppens et al. and Hayashi et al. because Busch does not pertain to “a packaging material or a planographic plate”, but one of ordinary skill in the art would have been motivated to consult Busch because Busch pertains to coated paper, and

Art Unit: 1772

Hayashi et al. disclose that coated paper is a suitable kind of paper for the sheet of paper (col. 2, lines 39-42) as stated in paragraph 19 of the previous Office Action mailed October 29, 2004:

Busch goes into some detail about the formation and composition of coated paper.

6. Applicant's arguments presented on pages 20-22 of the After Final Amendment regarding the 35 U.S.C. 103 rejection of claim 28 have been fully considered but are not persuasive. Applicant argues that there is no teaching in Coppens et al. that the paper spacer is a means for preventing peeling of the imaging surface of the planographic printing plates, but the paper spacer is necessarily a means for preventing peeling of the imaging surface of the planographic printing plates insofar as the paper spacer separates the imaging surface of one plate from the non-imaging surface of another plate, reducing damaging frictional interactions between those two surfaces while the imaging surface is fed through the feeding mechanism. Applicant's statement that "[i]f an interleaf sheet of Hayashi is applied to the printing plates of Coppens, air permeability will be excessively large and stability of sensitivity will not be maintained" is unsupported. Applicant's statement that "[i]f a sheet of Hayashi is applied to the printing plate system as set forth in claim 28, the smoothness will be excessively large and peelability will considerably deteriorate" is also unsupported, and is not directed to the proposed combination of references at issue of Coppens et al. and Hayashi et al.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

Art Unit: 1772


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh

04/18/05

WBA


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772 4/18/05